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| 10/784,892 | 02/24/2004 | Bengt Lejdstrom | 4010-38 | 9991 |
| 23117 7590 10/31/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | | |
| EXAMINER | | | | |
| SUBRAMANIAN, NARAYANSWAMY | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3695 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,892

Applicant(s)

LEJDSTROM ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/308)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This office action is in response to applicant's communication of June 3, 2008.

Replacement drawings, amendments to the specification including the abstract, amendments to claims 1-2 and addition of new claim 3 have been entered. Rejections made under 35 USC § 101 and under 35 USC § 112, second paragraph in the last office action have been withdrawn in view of the amendments. Claims 1-3 are pending and have been examined. The rejections and response to arguments are stated below. Applicants are requested to note the Examiner's new art unit number (AU 3695) in their reply to this office action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because they are drawn to a system with single means. A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Claim 2 is drawn to a system

comprising a computer configured to perform several sub-processes. The sub-processes are interpreted to correspond to software and not tangible hardware components. Claim 2 is in essence drawn to a system with single means. Appropriate correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: Claim 3 recites automated, computer-implemented apparatus comprising a clearing computer and a settlement computer. However the structural relationship between these two computers is missing in the claim.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation “an automated clearing process implemented by a computer and an automated settlement process implemented by a computer”. It is not clear if the computer implementing the clearing process is the same as the implementing the settlement process. It is not clear also if the “automated sub-process steps implemented by a computer” is the same as one of the other two computers. Hence the scope of the claim is unclear. Appropriate correction is required.

The rejections given below are interpreted in light of these 112, second paragraph rejections.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over et al. (US Patent 6,247,000 B1).

Claims 1-3, Hawkins discloses an automated computer-implemented method and an automated system for carrying out financial transactions within a Central Securities Depository (CSD), the method comprising an automated clearing process implemented by a computer and an automated settlement process implemented by a computer, the clearing process preparing transaction for the settlement process, using the following automated sub-process steps implemented by a computer: selecting a settlement rule to be followed in the clearing process, the rule defining how the transaction is to be settled (See the entire disclosure of Hawkins especially Abstract, Figures 5-7 and 30, Col 2 line 52 – Col 42, Col 7 line 59 – Col 8 line 47, Col 23 lines 4-15, matching transactions automatically results in the selecting a settlement rule), defining a settlement obligation group, including a number of settlement instructions to be settled at the same time (See the entire disclosure of Hawkins especially Abstract, Figures 5-7 and 30, Col 2 line 52 – Col 42, Col 7 line 59 – Col 8 line 47, Column 11 line 55-67, netting and block confirmations imply a settlement obligation group), locking in of the assets to which the transaction concerns, the locking-in having the effect of reserving said assets for a specific

settlement (See the entire disclosure of Hawkins especially Abstract, Figures 5-7 and 30, Col 2 line 52 – Col 42, Col 7 line 59 – Col 8 line 47, Col 27 lines 25-34, safekeeping is interpreted to include this feature), and the settlement process includes the following automated sub-process steps implemented by a computer: selecting transfer instructions for all settlement obligations belonging to said settlement obligation group, said transfer instructions being irrevocable instructions to transfer the locked-in assets between participants in the CSD (See the entire disclosure of Hawkins especially Abstract, Figures 5-7 and 30, Col 2 line 52 – Col 42, Col 7 line 59 – Col 8 line 47, Column 11 line 55-67, netting and block confirmations are interpreted to include this feature), checking that said transfer instructions are carried out successfully, and reporting the result of the settlement to the participants involved (See the entire disclosure of Hawkins especially Abstract, Figures 5-7 and 30, Col 2 line 52 – Col 42, Col 7 line 59 – Col 8 line 47, Column 11 line 55-67, Col 21 lines 25-36). A system with computers to perform the processes is inherent in the disclosure of Hawkins.

Response to Arguments

8. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on the attached form PTO-892.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Narayanswamy Subramanian/
Primary Examiner
Art Unit 3695